

Serial No. 10/748,737  
Art Unit 1616

Docket No. HC12U-US

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JUN 15 2007

### REMARKS

In view of the foregoing amendments and the following representations, reconsideration and allowance is respectfully requested.

Claims 13-24 are pending. In the Office Action, Claims 13-24 were rejected. Claims 16-17 were rejected under 35 U.S.C. § 112, second paragraph as allegedly indefinite. Claims 13-16, 19-24 were rejected under 35 U.S.C. § 103(a) as defining subject matter that is allegedly rendered obvious by U.S. Patent Appln. No. 20030049212 to Robinson, *et al.* (hereinafter "Robinson"). Claims 17-18 were rejected under 35 U.S.C. § 103(a), as defining subject matter that is allegedly obvious over Robinson in combination with U.S. Patent No. 4,704,271 to Hourihan, *et al.* (hereinafter "Hourihan"). Additionally, Claim 22 was objected to for improper format but it is believed the Examiner actually was referring to Claim 24.

At the outset and before addressing the rejections raised in the Official Action, Claim 24 has been amended to remove reference to withdrawn Claim 6. As amended Claim 24 includes the features of Claim 6. No new matter is added via this amendment.

Turning to the 35 U.S.C. § 112, second paragraph rejection, the Office Action avers that improper dependency of Claims 16.

Via this amendment, the dependency of Claims 16 has been corrected. Therefore, Applicant respectfully submits that this rejection of Claims 16 and 17, which depends from Claim 16 is obviated. Additionally, Claims 17 and 18 have been amended to correct the spelling of triglycerol.

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Turning to the 35 U.S.C. § 103(a) rejections, specifically the Office Action avers that for Claims 13-16 and 19-24, Robinson discloses emulsion compositions to treat the hair including shampoos containing silicone elastomers including organopolysiloxane and dimethicone/vinyl dimethicone crosspolymers in amounts of 0.1-3%, preferably 2-10% as described at paragraphs [0016] [0075] [0087] [0089][0135] [0213], and an emulsifier for dispersing the aqueous phase having a HLB of <14, ethoxylated esters and surfactants. The Examiner acknowledges that Robinson does not exemplify hair shampoo/conditioner compositions with the claimed components of the present invention but then states it would have been obvious to look to guidance provided by Robinson to formulate the silicone elastomer composition of Robinson into a shampoo or hair conditioner to arrive at the present invention.

Applicant respectfully traverses this rejection, and requests reconsideration.

A *prima facie* case of obviousness requires the analysis supporting a rejection under 35 U.S.C. 103(a) to be made explicit, and that it was "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *KSR Int'l Co. v. Teleflex, Inc* (Opinion 04-1350; decided April 30, 2007). Moreover, the prior art reference or combined references must teach or suggest all the claim limitations.

The present invention is directed to improved hair compositions that keep hair cleaner for a longer period of time while maintaining a smooth feel and long-lasting conditioning effects. The improvement is more than the predictable use of prior-art elements according to their established functions. As described in Claim 1, the emulsions have a silicone elastomer, a water-dispersible ester, and a hair treatment active agent selected from the group consisting of surface active agents and hair conditioning agents.

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Unlike the present invention, the emulsions of Robinson are directed to active ingredients which require a tacky solvent to insure solubility, such as the emollient glycerin. The tacky solvent prevents the active ingredient from being insufficiently dissolved which would result in a gritty feel. The purpose of the silicone elastomers in Robinson is to reduce the tackiness/stickiness of the "tacky solvent" to maintain good skin feel and, as recited in the Robinson specification at [0011], so that the "mixture of tacky solvent and the skin care active has a sensory tactile perception rating of greater than 4.5 and the resulting composition has a sensory tactile perception rating of less than 4.5". Also, at [0329] it states, "The combination of the tacky solvent and the solvent soluble skin care active used herein have a sensory tactile perception rating of greater than 4.5 and the topical skin care composition has a sensory tactile perception rating of less than 4.5. Preferably, the topical skin care composition has a sensory tactile perception rating of less than 3.0, more preferably less than 1.0". Robinson fails to teach or suggest use of a silicone elastomer to deter the build-up of sebum on the surface of the hair to keep hair cleaner for a longer period of time while maintaining a smooth feel and long-lasting conditioning effects. There is no suggestion or teaching in Robinson for use of silicone elastomers to absorb sebum. Nor would one skilled in the art at the time of the invention faced with the issue of trying to deter the build-up of sebum, have looked to Robinson for a solution to the present problem. Therefore, the product of Robinson does not possess or render obvious the same properties as the present invention.

Moreover, the Federal Circuit has stated:

"We have noted elsewhere, as a "useful general rule," that references that teach away cannot serve to create a *prima facie* case of obviousness.... If references taken in combination would produce a "seemingly inoperative device," we have held that such references teach away from the combination and thus cannot serve as predicates for a *prima facie* case of

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obviousness.” McGinley v. Franklin Sports Inc., 262 F. 3d 1339, 60 USPQ2d 1001, 1010 (Fed. Cir. 2001); In re Sponnoble, 405 F.2d 578, 587, 160 USPQ 237, 244 (C.C.P.A. 1969).

Applicants further submit that the high levels of tacky solvents (e.g. 15%) in Robinson, necessary to fully dissolve the desired levels of active ingredient such as niacinamide, will leave behind a residue on the hair. Thus, Robinson renders the hair with a “dirty” rather than clean feeling and teaches away from the present invention, such teaching away being indicative of non-obviousness.

Moreover, shampoos require high foaming for lathering and the consequent desirable sensory attributes of providing the consumer with a perceived indication that the product is functioning as a cleanser. Robinson requires use of tacky solvents, especially glycerin to solubilize the active ingredient. These tacky solvents of Robinson described at paragraph [0072] are anti-foaming agents. Glycerin is a well-known anti-foaming agent. Anti-foaming agents interfere with the foaming properties of surfactants and, thus, are contraindicated for use in shampoos. Therefore, Robinson further teaches away from the present invention, such teaching away being indicative of non-obviousness.

Unlike the present invention, the Robinson composition is not directed to a method for treating the hair by applying a composition directed to crosslinked silicone elastomers and silicone elastomer powders, the silicone elastomer in an amount effective to deposit a sebum-absorbing level of said crosslinked silicone elastomer on the hair or scalp. In fact, nothing in Robinson refers to a method for sebum reduction or keeping hair cleaner for longer. *See* Robinson [0335-0338]. Robinson neither recognizes the problems solved by the present invention, nor teaches use of a composition to solve these problems. Nor does Robinson teach or suggest an amount of silicone elastomers effective for depositing “a sebum absorbing level”, said

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level having been experimentally determined as described in the formulation examples of the present invention.

Applicants submit that obvious cannot be predicated on what is unknown. *In re Sporman*, 363 F.2d 44,448 (C.C.P.A. 1966). Inasmuch as Robinson does not teach or suggest a method for keeping hair cleaner for longer by depositing a sebum-absorbing level of a composition containing a crosslinked silicone elastomer, Robinson cannot render the present invention obvious.

Based on the above arguments distinguishing the present invention and that of the Robinson application, it is respectfully requested that the rejection be withdrawn.

Pursuant to the rejection of Claims 17 and 18 under 35 U.S.C. § 103(a), the Examiner states that Robinson teaches nonionic surfactants including polyglycerol esters of C<sub>1</sub>-C<sub>30</sub> fatty acids but does not teach the instantly claimed esters. The Examiner then relies on Hourihan to teach polyglyceryl-3-laurate at column 3, lines 55-68. According to the Examiner, it would have been obvious to use any emulsifying polyglycerol ester of C<sub>1</sub>-C<sub>30</sub> fatty acids.

Applicant respectfully traverses this rejection.

Regarding Claims 17 and 18, Applicants submit that Hourihan is directed to non-analogous art, i.e. an antiperspirant stick. Hourihan is directed to antiperspirant compositions for application to the skin. Hourihan is not directed to hair care compositions. Hence, this reference is not useful for the purposes of the present invention. Applicants submit that the Examiner has engaged in selective picking and choosing to the portions of the references without full appreciation of the references as a whole. *See Bausch & Lomb, inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443 (Fed. Cir. 1986). Moreover, there has been no attempt to apply the factors recited in *Graham v. John Deere Co.*, 383 U.S. 1 (1966) to the references cited.

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Even *assuming arguendo* that Hourihan could be applied here, which it cannot, Claims 17 and 18 of the present invention are directed to specific polyglycerol esters having an HLB of about 10 and above. Unlike the present invention, at column 2, lines 30-31 and column 3, lines 56-64 of the Hourihan reference, the HLB of the esters must be between 6-9. Claims 17 and 18 of the present invention preclude use of a composition having esters between 6-9. Therefore, Hourihan teaches away from the present invention and such teaching away is indicative of non-obviousness.

*A prima facie* 35 U.S.C. § 103 rejection must show two or more references, when combined in an obvious manner, show each and every limitation of the claims. In this case, combining the Robinson application with the Hourihan Patent does not lead to the present invention inasmuch as each and every element is not present. Moreover, the combination does not render Claims 17 and 18 obvious. The combination does not contain a polyglycerol ester having an HLB of 10 or greater, and therefore, the combination cannot overcome this deficiency.

Applicants submit that the proposed motivation to combine supplied by the Examiner represents circular argument. That is, "motivated to do so since Robinson suggests the use of polyglycerol esters and Hourihan teaches such esters." The Examiner has not explicitly stated and identified a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed.

There are a number of other features of the present invention which are not suggested by either reference.

Inasmuch as Claims 14-24 are dependent upon Claim 13, the present invention cannot be rendered obvious over Robinson, either alone, or in combination with Hourihan for at least the

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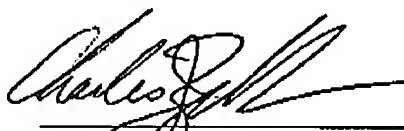
reasons provided above. Therefore, withdrawal of the rejection of Claims 13-24 is respectfully requested.

In consideration of the differences between the present invention, the Robinson patent application, and the Hourihan patent, as explained above, it is submitted that the claims define subject matter that is patentable over the references cited, and withdrawal of the rejections is in order and is respectfully requested.

The above amendment and remarks establish the patentable nature of all the claims examined on the merits in the application. Notice of Allowance and passage to issue is therefore, respectfully solicited.

Please charge any additional fees or credits any such fees, if necessary to Deposit Account No. 50-3782 in the name of Avon Products, Inc. A duplicate copy of this sheet is attached.

Respectfully submitted,



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